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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,049

03/02/2004

Xiaorong Wang

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03/11/2009

BRIDGESTONE AMERICAS HOLDING, INC.  
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EXAMINER

MULLIS, JEFFREY C

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,049	<b>Applicant(s)</b> WANG ET AL.	
	<b>Examiner</b> Jeffrey C. Mullis	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 18-22, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17, 23-25, 27-31 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10-14-08; 10-20-08; 11-24-08; 12-15-08; 1-15-09; 1-30-09; 2-24-09.

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The declaration under 37 CFR 1.132 filed 12-11-08 is sufficient to overcome the rejection of claims 10-17, 23-25, 27-31, 34 and 35 based upon Wang et al. (US 6,956,084).

The declaration under 37 CFR 1.132 filed 12-11-08 is sufficient to overcome the rejection of claims 10-17, 23-25, 27-31, 34 and 35 based upon Wang et al. (US 6,875,818).

Claims 36 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The ratios in claims 36 and 37 were not disclosed by the specification as filed and are therefore new matter.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-17, 23-25, 27-31, and 34-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6875818. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set out at the paragraph bridging pages 5 and 6 of the Office action of 9-11-08.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-17, 23-25, 27-31, and 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Krom et al. (US 6,437,050).

See the paragraph bridging pages 7 and 8 of the Office action of 9-11-08.

The declaration under 37 CFR 1.132 filed 7-21-08 is insufficient to overcome the rejection of claims 10-17, 23-25, 27-31, 34 and 35 are based upon Krom as set forth in the last Office action because: Applicants declaration deals with their belief as to the factual teachings of the reference. However the pertinent issue is whether or not the block attached to the diblock moiety of patentees is a “monoblock. This is an issue of the scope of the claims not an issue of the factual teachings of the reference. Furthermore the term “monoblock” appears only in claim 10 and those dependent thereon.

Claims 10, 13-17, 23-25, 27-31, and 34-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wooley JP2000514791, using US 6383500 as a translation.

Patentees disclose a core shell particle composition (abstract) wherein the inner layer may be formed from anionic polymerization of styrene and the outer layer of polymerized alkylene such as vinyl pyridine(Example 3 at column 74). Since a diblock copolymer as is disclosed in the examples is two monoblocks attached to each other the limitations of the claims are met. While the term “polymodal” is disclosed polymers are generally not monodisperse and as such can generally be viewed as having an infinite number of modes.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

JP2000514791 is newly cited by applicants after payment of a 1.17(p) fee and accordingly this Office action can be made final even though it contains a new grounds of rejection based on said reference, MPEP 609.

Applicant's arguments filed 12-11-08 have been fully considered but they are not persuasive. No terminal disclaimers have been received by the Office.

Applicants argue that applicants "and the Examiner agree that mono-block polymer means a homopolymer". The present Examiner does not agree that a "mono-block" is necessarily a homopolymer but in any case even assuming that applicants and the previous examiner are correct numerous patents disclose the term "homopolymeric block" or "homopolymer block" when referring to sequences of identical units attached to the end units of other polymers, ie as part of a multiblock copolymer. Note for instance paragraph 82 of Evaerts newly cited and numerous others. Applicants are requested to point out where in the record the previous examiner expressed disagreement with applicants regarding the interpretation of what would occur when "additional monomer is added in Krom at column 3, lines 16-19. The present examiner sees no clear indication that the previous examiner's disagreement was anything but a disagreement in claim interpretation. The term "polydispersity" generally is referred to in the art to as pertaining to molecular weight distribution. Applicants claims however refer to "polydispersity" of the nanoparticle (although they might possibly be said to be one and the same for a collection of particles each of which consists only of one chain). Assuming for the sake of argument however that applicants "polydispersity index" refers to molecular weight distribution, patentees polydispersity of "about 1.3" (as is disclosed by the reference within the meaning of 35 USC 102) certainly encompasses "about 1.5" as recited by the

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claims. Since the "further" monomer described by patentees at column 3, line 10 would add to the active chain ends already present a ration of mono to diblock of about 1 would result.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis, M-F, 9-5 pm at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

3-5-09



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/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796